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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

M-9381 US

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Signature

Typed or printed name

Edward C. Kwok

Application Number

09/785,783

Filed

February 16, 2001

First Named Inventor

Robert A. Foster

Art Unit

3627

Examiner

Gort, Elaine L.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

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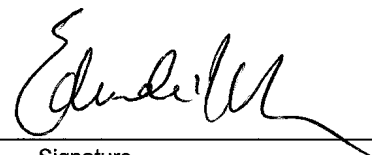
☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record. **33,938**
Registration number

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34



Signature

Edward C. Kwok

Typed or printed name

(408) 392-9250

Telephone number

February 14, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 09/785,783 Filing Date: February 16, 2001
Confirmation No.: 3408
First Named Inventor: Robert A. Foster
Assignee: Financial Systems Technology (Intellectual Property) Pty. Ltd.
Examiner: Fischer, Andrew J. Art Unit: 3627
Attorney Docket No.: M-9381 US

San Jose, California
February 14, 2007

Via EFS-Web
Commissioner for Patents
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REASONS FOR REQUESTING PRE-APPEAL BRIEF REVIEW

Dear Sir:

These reasons support the Pre-Appeal Brief Request for Review filed in response to the Final Office Action of November 7, 2006 ("Final Office Action"). Claims 1-38 are appealed.

In the Final Office Action, the Examiner rejected Claim 1-38 under 35 U.S.C. § 112, second paragraph, as being indefinite. The Examiner states:

In claims 1-38, it is unclear what Applicant asserts as a transaction or contract to buy. In view of James J. White and Robert S. Summer's Uniform Commercial Code, 4th Ed., ("White & Summers") § 3-8, it is the Examiner's factual determination that what constitutes an end of sale is indefinite. In other words, a standard contract requires at a minimum, a firm price and quantity. White & Summers states that when price is agreed to at a later date, the transaction has in effect not ended. Only when the price is known is the transaction actually completed. It is therefore indeterminate as to when the transaction is completed.

Applicant's Specification's provides, on page 32, lines 3-5:

"Transaction" here generally refers to a product or service that is offered by a provider (e.g., manufacturer, retailer, wholesaler, distributor, service provider, etc.) for consumption by one or more consumers.

As pointed out in Applicant's previous Amendment of November 22, 2005 ("Previous Amendment"), the term "transaction," as recited in the Specification, is consistent with its ordinary and customary meaning. Therefore, the Examiner's attempt to import a much narrower meaning for the term "transaction" from an extrinsic source (i.e., the meaning of a "transaction" under contract law, as provided in White and Summers) is improper. In response to Applicant's argument, the Examiner states in the Final Office Action:

... [W]ords of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification. The definition of "transaction" presented in the Applicant's Amendment is unclear as it states that a transaction refers to a product or service that is offered for consumption, but does not state what is actually being claimed as a "transaction". Webster defines a transaction to include an exchange of goods, services and funds. Is the Applicant merely claiming the offering of goods or services and no actual exchange? It remains unclear if the Applicant is claiming an "offer" or an actual "transaction" where an exchange occurs.

Applicant respectfully disagrees. The meaning given to the term "transaction" in Applicant's Specification, as quoted above, is substantially the same as the meaning given in Webster, which the Examiner provides as example here. Applicant respectfully submit that the Applicant's claims comply with 35 U.S.C. § 112, second paragraph, even if Webster's meaning for "transaction" above is used. Thus, Applicant's Specification uses the term "transaction" consistently with its ordinary and customary meaning. Therefore, the Examiner's insistence in giving the term "transaction" its narrow, technical meaning under contract law, as used by White and Summers, is simply unreasonable and incorrect. Reversal of the Examiner's rejection under 35 U.S.C. § 112, second paragraph, is therefore requested.

The Examiner rejected Claims 1-38 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,10,484 (“Halbert”), in view of U.S. Patent 6,324,522 (“Peterson”). The Examiner relied on Halbert’s col. 4, lines 25-29 and Peterson’s col. 27.

In response, in Applicant’s Previous Amendment, Applicant quoted Halbert’s col. 4, lines 25-29 in its entirety to demonstrate that the portion of Halbert relied upon by the Examiner does not disclose or suggest the “determining” steps in the limitations of Applicant’s Claims 1, 9 and 26, each of which reciting a billing cycle, production service instances and a pricing method:

Featured Product: Any product or product variant identified for sale through a co-op. For purposes of this application, the term ‘featured product’ includes any services which might be identified for sale through a co-op.

HTTP: The Hyper-Text Transfer Protocol.

For brevity, the specific recitations of Claims 1, 9 and 26 are not reproduced here, but can be found in Applicant’s Previous Amendment. In the Previous Amendment, Applicant also pointed out that the specific limitations are also neither disclosed nor suggested by Peterson. In response to the Previous Amendment, the Examiner states in the Final Office Action:

Examiner notes that the rejection is based on the Halbert reference, not just col. 4, lines 25-29. Examiner contends that Halbert discloses all the determining steps. For example the determining of a first production service (C4, lines 25-29 disclose where the featured product includes services which is inherently determined when the seller offers the services for sale via the system), the first production service being a component of the transaction (for example in the sale of a service the service is a component of the transaction. Examiner, for example, construes this to include services such as the sale of a service warranty contract.);

The Examiner then further refers to Halbert’s col. 3, lines 7+ and Halbert’s Abstract. For brevity, the Examiner’s lengthy comment is not reproduced. However, the Examiner’s reading of Applicant’s claims on Halbert is not supported by Halbert. For

example, with respect to Claim 1's limitations:

determining a total of the first production service instances associated with the one or more related accounts during the billing cycle up to the first instance in time, the total including the count of the first production service instances in the transaction;

determining a price applicable to the total of the first production service instances based on a pricing method;

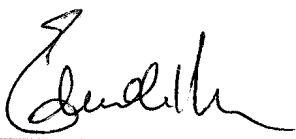
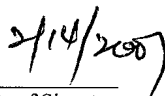
the Examiner states:

Halbert discloses, for example in the abstract, that the sale has a defined start time and end time which the Examiner is construing to be a "billing cycle". When the sale ends a total of the number of services sold is inherently used in order to calculate the amount to be charged to the buyer's credit card account in order to obtain adequate funds. ... Halbert disclose the determining of a price based on a pricing method, for example in the abstract it discusses how the system uses a starting price and a product cost curve. In Halbert the cost is reduced as the number of goods/services purchased increases to take advantage of group buying discounting.

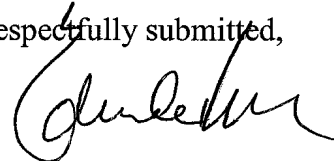
However, the Examiner's construction is unreasonable. If the Examiner construes the term "one or more related accounts" as a credit card account, then the "billing cycle" for such an account cannot be the "start time" and the "end time" of a single transaction (as the Examiner construed), but rather the time period when transactions are allowed to accumulate in the credit card account. If that is the case then, Halbert's price determination for a single transaction, as discussed in the Abstract and by the Examiner above, does not meet Claim 1's limitation "determining a price applicable to the total of the first production service instances based on a pricing method", as Halbert does not disclose or suggest determining a price for a transaction based on the total up-to-date transactions in the credit card account in the present billing cycle. Therefore, at least for this reason, Claims 1-38 are allowable over the combined teachings of Halbert and Peterson.

The Examiner's comments in paragraphs 5-6 of the Office Action are irrelevant in view of the Examiner's failure to take Applicant's Specification into consideration in his construction of the claims (e.g., the Examiner ignored the meaning of the term "transaction" as used in Applicant's Specification, at page 32, lines 3-5, and also because the meaning provided in the Specification is consistent with the dictionary meaning advocated by the Examiner).

For the reasons stated above, Applicant believes that all pending claims (i.e., active Claims 1-38) are allowable. If the Examiner or the Board has any questions regarding the above, the Examiner is requested to telephone the undersigned at (408) 392-9250.

Certificate of Transmission: I hereby certify that this correspondence is being transmitted to the United States Patent and Trademark Office (USPTO) via the USPTO's electronic filing system on February 14, 2007.	
	
Attorney for Applicant(s)	Date of Signature

Respectfully submitted,



Edward C. Kwok
Attorney for Applicant
Reg. No. 33,938

Law Offices of
MacPherson Kwok Chen & Heid LLP
2033 Gateway Place, Suite 400
San Jose, CA 95110
Tel: (408) 392-9250
Fax: (408) 392-9262